

REMARKS

Please amend claims 1 and 9 as set forth above.

Please cancel claims 2-6 and claims 11-14.

I. Statement of Substance of Interview with Examiner McAnulty on December 1, 2003.

The Farrow et al. reference and the Krauss references were discussed. The undersigned identified the differences in the structure and function of Applicant's present invention as compared to structure and function of the Farrow et al. and Krauss references.

The Examiner suggested that the claims be amended to more clearly reflect the differences in structure and function between Applicant's invention and the Farrow et al. and Krauss references. Specifically, the Examiner suggested that further clarification was required with respect to the scope of the term "upwardly" as used in claim 1 by claiming the orientation or relation of the direction of the oil filter canister and the oil containment boot with respect to the oil filter receiving base. Additionally, the Examiner suggested that Applicant amend the claims to more clearly distinguish the Krauss reference which discloses that the cover 16, 60 is sealed against the sidewalls of the oil filter canister such that cover 16, 60 would be removed from the engine block along with the removal of the oil filter canister. Whereas, the oil containment boot of Applicant's present invention is secured to the oil filter receiving base and thus stays secured thereto while the oil filter canister is removed.

Regarding the Office's objections to the drawings under 37 C.F.R. § 1.83(a), the undersigned elected to amend claims 1 and 9 by claiming the "restraint . . . for sealingly securing" and the step of "sealing securing", respectively, in means-plus-function format, thereby obviating the need for revising or adding new drawings. The Examiner acknowledged that the

foregoing amendment would overcome the Offices objections to the drawings under 37 C.F.R. § 1.83(a).

II. Amendment to Specification

Applicant has amended Paragraph [0004] line 4 to correct a typographical error.

III. The Office's Objections to the Drawings

The Office objected to Applicant's drawings as not conforming to 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Although Applicant traverses the Office's objections to the drawings, Applicant has amended claim 1 to express the limitation -- "restraint . . . for sealingly securing . . ." in means-plus-function format. Similarly, Applicant amended claim 9 to express the limitation -- "sealingly securing . . ." in means plus function format. As such, the Office's objection with respect to the drawings is overcome without having to amend or add new drawings, because a means-plus-function clause under 35 U.S.C. § 112 ¶ 6 is by definition "construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof." Paragraph [0019] of the specification specifically discloses the various alternative structures expressly claimed in claims 3, 4, 5 and 6 as well as the various alternative methods expressly claimed in claims 11, 12, 13 and 14.

Claims 3, 4, 5 and 6 have been cancelled in view of the amendment to claim 1 because their scope is necessarily within the scope of claim 1 as amended with the foregoing means-plus-function clause. Claims 11, 12, 13 and 14 have also been cancelled in view of the amendment to claim 9 because their scope is necessarily within the scope of claim 9 as amended with the foregoing means-plus-function clause. As such claims 3, 4, 5, 6, 11, 12, 13 and 14 are cancelled with the understanding that no subject matter has been disclaimed by cancellation of those claims

and with the understanding that the scope of claim 1 and claim 9 have not been narrowed by the foregoing amendments.

IV. The Office's Objection to Claim 1.

Claim 1 was amended to insert the term – inverted – before "oil filter canister" in accordance with the Office's requirement.

V. The Office's Claim Rejections – 35 U.S.C. § 103

The Office rejected claims 1, 6-9 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable obvious over Krauss in view of Farrow et al. The Office asserts that Krauss discloses all of the structural and functional features of Applicant's above-referenced claims except for an inverted oil filter. The Office asserts that Farrow et al. discloses an inverted oil filter and therefore it would have been obvious to modify the apparatus of Krauss in view of Farrow et al. to provide an oil containment apparatus in combination with an inverted oil filter so as to reduce oil spillage when removing the inverted oil filter.

Applicant respectfully traverses the Office's 103 rejection and submits that the Office has failed to establish its prima facie case of obviousness based on the cited references. "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1447 (Fed. Cir. 1992); 35 U.S.C. § 132. "The patent applicant may then attack the Examiner's prima facie case determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness." *In re Fritch*, 23 U.S.P.Q. 2d at 1783. "[T]he presence or absence of the prima facie case of obviousness controls the need for the applicant to adduce rebuttal evidence of unobviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1788, 1788-89 (Fed. Cir.

1990) (en banc) (Newman, J., dissenting) (citing *In re Johnson*, 747 F.2d 1456, 1460 (Fed. Cir. 1984).

To establish its prima facie case of obviousness the Office must identify "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings in the references." *In re Fritch*, 23 U.S.P.Q.2d at 1783. As held by the Federal Circuit: "The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (citations omitted).

The Krauss reference discloses only the use of a "cover" 16, 60 that seals around an oil filter canister 12 mounted in a conventional manner at the bottom or side of an engine block 10. Thus, the cover 16, 60 of Krauss catches the oil escaping from the engine block upon removal of the oil filter canister. Thus, Krauss is completely silent with respect to an inverted oil filter, and fails to disclose, teach or even suggest an oil containment boot adapted to contain oil from an inverted oil filter canister.

With respect to the Farrow et al. reference, although the Farrow et al. reference discloses the use of an inverted oil filter canister on a hydraulic reservoir, the oil filter canister is used as an air filter for a hydraulic system— NOT to filter the hydraulic fluid. Thus, Farrow et al. is directed to a completely different field of art from Applicant's claimed invention and is directed toward a problem unrelated to that which Applicant's invention is directed. As such, the Office fails to set forth an adequate showing that one of ordinary skill in the art would even be motivated to look to the Farrow et al. reference to combine their teachings. "[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

Furthermore, even if the Office maintains that one of ordinary skill would have been motivated to combine Krauss with Farrow et al., the Office fails to identify the necessary teaching in Krauss or Farrow et al. which would motivate one of skill in the art to produce Applicant's claimed invention. As previously discussed, the oil filter canister 12 of Krauss is not inverted. Thus, the oil within the oil canister 12 will remain in the canister until it is inverted. If the oil filter canister 12 is inverted, the oil will spill out of the oil filter canister 12 and will not be contained by the cover 16, 60, because the cover too will be inverted as it is sealed around the canister. The Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made. *See e.g., In re Gordon*, 733 F.2d 900 221 USPQ 1125 (Fed. Cir. 1984). MPEP § 2145 X.D.2.; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (It is improper to combine references where the references teach away from their combination); *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (Teaching away in the art from going in the claimed direction is a per se demonstration of lack of prima facie obviousness).

Additionally, it is legally improper to focus on the obviousness of the substitutions and differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to the prior art. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383 (Fed. Cir. 1986) cert. denied, 480 U.S. 947 (1987). As identified above, Krauss is completely silent as to the use of the cover 16, 60 on an inverted oil filter

canister, and in fact teaches away from such applications. Thus, it is submitted that the Office is using Applicant's claimed invention as an instruction manual or "template" to pick and choose among isolated disclosures in the prior art to piece together the Applicant's claimed invention in order to render it obvious. Such a practice is improper. *In re Fritch*, 23 U.S.P.Q. 2d at 1784. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures*, 43 U.S.P.Q. 2d at 1297.

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art. . . . By defining the inventor's problem in terms of its solution, the district court missed this necessary antecedent question, namely, whether the prior art contains a suggestion or motivation to combine references to form a trend.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 U.S.P.Q.2d 1977, 1981-82 (Fed. Cir. 1998).

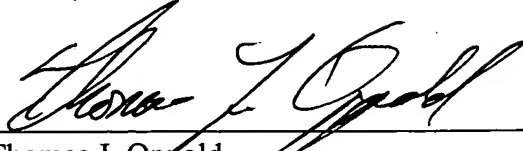
Based on the foregoing, Applicants submit that the Office has failed to establish its prima facie case of obvious based on the cited references. As such, the Office 103(a) rejection is improper and should be withdrawn.

Even if the Office maintains that it has established a prima facie case of obviousness, Applicant's amendments to claims 1 and 9 in response to the Examiner's comments and suggestions during the telephone interview on December 1, 2003 as set forth above overcome the Office's 103 rejections. As such, it is submitted that pending claims 1, 7, 8, 9, 15 and 16 are in a condition for allowance. Accordingly, Applicants' respectfully request that a timely notice of allowance be issued in this case.

Respectfully submitted,

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CERTIFICATE OF EXPRESS MAILING

Pursuant to 37 C.F.R. § 1.10, I hereby certify that the foregoing Amendment and accompanying documents in application Serial No. 10/065,182 are being deposited with the United States Postal Service by "Express Mail Post Office to Addressee" service, addressed to: Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, as of the date and under the mailing label indicated below:

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